

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **Arnold G. Slezak**

Assignee: **Seagate Technology LLC**

Application No.: **09/981,556**

Filed: **October 17, 2001**

Group Art Unit: **3729**

Examiner: **Anthony D. Tugbang**

For: **METHOD TO REDUCE SERVO PATTERN RUNOUT ON A PREWRITTEN DISC**

Mail Stop AF

Commissioner for Patents

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COMMENTS FOR PRE-BRIEF REQUEST FOR REVIEW

Section 112(1) Rejection

Claims 1, 3, 5-9, and 21-24 stand rejected as allegedly failing to comply with the written description requirement.

The Office in its most recent action factually mischaracterizes the record by stating:

The applicant(s) description of their invention (on pages 10 through 12 of their last response) is in terms of alignment marks. However, the claims never describe the invention in terms of alignment marks.”¹

Actually, on pg. 12 of that response Applicant quotes a passage from the Specification that includes this statement:

In yet another preferred embodiment, no alignment mark is placed on the prewritten disc at all.

Based on its mischaracterization, the Office concludes that the written description only discloses distributing alignment marks symmetrically, not alignment axes. However, Applicant has shown in the record that the “oppositely” and “even intervals” distributions

¹ Advisory Action pg. 2.

recognized by the Board, in context, refer to both the embodiments that employ alignment marks and to the embodiments that do not employ the alignment marks.² The Office's requirement that the claims recite an "alignment mark," effectively an essential element rejection, is a factually incorrect rationale that ignores the Specification and thereby leaves an unresolved factual issue that must be addressed before this case is in condition for appeal.

The Office in its most recent action goes to great lengths to emphasize that the Board found "common angular reference axis" in the appealed claims to be indefinite.³ The Panel will appreciate that point is irrelevant because Applicant amended the claims to delete the disputed "common angular reference axis" language; the claims at issue now recite in pertinent part *servo tracks characterized by a concentricity offset in a direction of an alignment axis that is in the same angular direction for all of the plurality of prewritten discs in relation to a center of the respective prewritten disc....* The Office in its most recent action parses the claim language in a way that unnecessarily obfuscates the merits of the case. That is, the Office now ignores the concentricity offset feature recited by the claim language, instead construing in isolation the "direction of an alignment axis that is in the same angular direction for all of the plurality of prewritten discs in relation to a center of the respective prewritten disc," and thus concluding it is allegedly indefinite in the same way that "common angular reference axis" was before.⁴ Applicant has shown, without rebuttal by the Office, that FIG. 2 and the descriptions thereof clearly disclose the servo tracks being concentrically offset in the direction of the alignment mark for those embodiments employing the mark, and likewise in the direction of the alignment axis for those embodiments not employing the mark. The Office's ignoring explicitly recited claim

² Applicant's Response of 4/26/2010 pg. 11 referring to the Specification pg. 6:16 to 7:30.

³ Advisory Action ppg. 2-3.

⁴ Advisory Action pg. 2.

language to change the meaning of the claim to suit its rejection leaves an unresolved factual issue that must be addressed before this case is in condition for appeal.

The Office also in its most recent action, after ignoring the recited servo track concentricity term in construing “direction,” asserts that the “direction of an alignment axis...” could reasonably be into or out of the page in FIG. 2. Again, the disputed “direction” in the context of the claim language is *servo tracks characterized by a concentricity offset in a direction of an alignment axis....* Applicant has shown that the skilled artisan readily understands that servo tracks lie in the plane of the disc, and as such it is unreasonable (even nonsensical) to believe the servo tracks would be characterized by a concentricity offset in any direction other than within the plane of the disc.⁵ The Office’s ignoring the concentricity language in construing the “direction” term leads to the erroneous conclusion that the “direction” could be out of the disc plane, which is another unresolved factual issue that must be addressed before this case is in condition for appeal.

Applicant reiterates that the legal criteria for satisfying the written description requirement is whether Applicant has disclosed the technologic knowledge upon which the rejected claim is based, and demonstrated a possession of the claimed invention at the time of filing.⁶ Contrary to the Office’s stated position, there simply is no written description requirement that the criteria can only be satisfied in terms of the explicitly recited terms in the claim.⁷ Applicant has shown that the Office’s perceived written description deficiency is actually due to it ignoring parts of the Specification and also ignoring explicitly recited claim language in construing the claim, which is not a bona fide basis for taking this case to appeal.

⁵ Applicant’s Response of 4/26/2010 pg. 16.

⁶ *Ariad Pharmaceuticals v. Eli Lilly and Co.*, 2008-1248 (Fed. Cir. 2010) *en banc*.

⁷ Office Action pg. 3: “The specification, as originally filed, does not even use the terms of “angularly disposed” or “symmetrically.”

Section 112(2) Rejection

Claims 1, 3, 5-9, and 21-24 stand rejected as allegedly being indefinite.

The Office in its most recent action repeats the latter argument above in rebutting Applicant's argument that the claims clearly feature the alignment axis being within the plane of the disc. The Office's first erroneous rationale is that the meaning must be explicitly recited in stating: "the claims never recite "the same plane of the disc.""⁸ That forms the basis for the Office's erroneous second rationale that what is recited does not match what the Office believes must be recited.⁹ Again, as stated above, the disputed "direction" in the context of the claim language is *servo tracks characterized by a concentricity offset in a direction of an alignment axis*.... Applicant has shown that the skilled artisan readily understands that servo tracks lie in the plane of the disc, and as such it is unreasonable (even nonsensical) to believe the servo tracks would be characterized by a concentricity offset in any direction other than within the plane of the disc.¹⁰ The Office's ignoring the "concentricity offset" term in construing the "direction" term leads to the erroneous conclusion that the "direction" could be out of the disc plane, which has already been identified to be an unresolved factual issue that must be addressed before this case is in condition for appeal.

Applicant reiterates that the legal criteria for definiteness is whether the skilled artisan understands what is claimed when the claim is read in light of the specification.¹¹ The skilled artisan readily understands that an "alignment mark" disposed along a "radial axis" of the disc can meaningfully be defined in terms of an "alignment axis." For those embodiments not employing the visible alignment mark, the "alignment axis" clearly defines

⁸ Advisory Action pg. 4.

⁹ Advisory Action pg. 4: "Second, to describe the alignment axis as being "in the same angular direction for all of the plurality of prewritten discs in relation to a center of the respective prewritten disc, around a motor hub", is not the same thing as saying that the alignment axis are "in the same plane of the disc"."

the very same position that would otherwise be occupied by the “alignment mark.” In the context of the claim language, the servo tracks define a concentricity offset in the direction of the alignment axis: *each prewritten disc having servo tracks characterized by a concentricity offset in a direction of an alignment axis*. The skilled artisan having read the specification understands there is exactly one and only one radial axis along which the servo tracks define a concentricity offset, that being the radial axis including the alignment mark in those embodiments employing the mark. Accordingly, the skilled artisan having read the specification has no difficulty comprehending the meaning of “alignment axis” in view of the description of FIG. 2 and the contextual meaning ascribed by the rest of the claim language of which the disputed term “alignment axis” forms a part.

Conclusion

For these reasons Applicant respectfully requests that the Panel withdraw the final rejections for further prosecution to address the unresolved issues presently making the case not in condition for appeal.

Respectfully submitted,

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¹⁰ Applicant's Response of 4/26/2010 pg. 16.

¹¹ *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.* 806 F.2d 1565, 1576 (Fed. Cir. 1986).